The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEON THRANE

Appeal No. 2006-1945
Application No. 09/691,775

ON BRIEF

Before HAIRSTON, KRASS, and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-23.

The invention pertains to information transformation in a computer system, particularly to a system for a content transformation for rendering data into a presentation format.

Representative independent claim 1 is reproduced as follows:

1. A content transformation method operated in a client-server communication system, the method comprising:

receiving a content request by a server from a client;

performing a first stage content transformation to generate a first stage data layout based upon said content request;

performing an intermediate stage content transformation using said first stage data layout to generate an intermediate data layout; and

performing a final stage content transformation using said intermediate data layout to generate a presentation format based on a device used by said client.

The examiner relies on the following references:

Yalcinalp	6,507,857	Jan. 14, 2003 (filed Mar. 10, 2000)
Boag et al. (Boag)	6,589,291	Jul. 08, 2003 (filed Apr. 08, 1999)
Thum et al. (Thum)	6,616,700	Sep. 09, 2003 (filed Jan. 07, 2000)

Claims 1-23 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Yalcinalp and Boag with regard to claims 1-7, 9-19, and 21-23, adding Thum to this combination with regard to claims 8 and 20.

Reference is made to the briefs and the answer for the respective positions of appellant and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must

show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience – or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-8, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the

relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii) (2004)].

With regard to independent claims 1 and 13, the examiner contends that Yalcinalp discloses the following:

"receiving a content request by a server from a client" is said to be described at column 4, lines 49-67, wherein server 104 receives client requests.
"performing a first stage content transformation to generate a first stage data layout based upon said content request" is said to be described at column 5, lines 7-50, wherein a transformed document is generated for a user in response to the document request.
"performing a final stage content transformation...to generate a presentation format based on a device used by said client" is said to be described at column 5, line 65 – column 6, line 13, wherein the transformed document will be formatted based on client type, e.g., a PDA or a browser on a PC.

The examiner recognizes that Yalcinalp lacks the teaching of the claimed "performing an intermediate stage content transformation using said first stage data layout to generate an intermediate data layout." However, the examiner points to column 8, line 39 – column 9, line 49, and column 10, lines 42-62, of Boag for a teaching of selecting one or more style sheets based on variable factors such as the target device and browser, and creating an output from the selected style sheets in a language appropriate for the wireless connection and the target device.

The examiner reasons that since Boag dynamically determines that the most appropriate location for applying style sheets on a client request depends on the capabilities of the client device, which is similar to processing a user request document to a transformed document and formatting the transformed document specific to the client specification of Yalcinalp, it would have been obvious to combine the teachings of Boag and Yalcinalp to include performing an intermediate stage content transforming using the first stage data layout to generate an intermediate data layout to provide a technique for increasing the applicability of style sheets when a style sheet tailored to a particular target environment is not readily available.

We will not sustain the rejection of claims 1-23 because, in our view, the examiner has clearly failed to present a prima facie case of obviousness with regard to the instant claimed subject matter.

The examiner admits that Yalcinalp fails to suggest the claimed "performing an intermediate stage content transformation using said first stage data layout to generate an intermediate data layout." Therefore, at a minimum, Boag must suggest such a step to even make a rejection under 35 U.S.C. § 103 viable. However, our review of this reference finds no such teaching or suggestion of the claimed "intermediate stage," contrary to the examiner's contention. While the examiner has cited a large portion of Boag's disclosure (columns 8-10) for such an alleged teaching, we find no such teaching.

The examiner employs the example of a user device being a Smart phone (see page 11 of the answer). The examiner contends that a request for a particular document over the wireless

connection of the Smart phone causes an application of a selected style sheet or sheets at the server for converting from one markup language to another, viz., HTML to WML (wireless markup language), because WML is the appropriate language for the wireless connection and the Smart phone device. The examiner concludes from this that Boag teaches the missing step of Yalcinalp, viz., performing an intermediate stage content transformation. It is unclear to us why, in this example, the transformation from HTML to WML is an "intermediate stage." Why isn't this the entire transformation? The examiner does not explain.

Moreover, assuming, arguendo, that what the examiner cites as an example could be considered an "intermediate stage," the examiner has still not convinced us of any reason why the skilled artisan viewing these two references would have modified Yalcinalp in any way by employing such an "intermediate stage" in Yalcinalp. The examiner's reason of "increasing the applicability of style sheets when a style sheet tailored to a particular target environment is not readily available" (answer-page 5) is not convincing. How does the insertion of some intermediate step in the transformation process of Yalcinalp increase "applicability of style sheets" and, absent appellant's disclosure of such a step, why would the skilled artisan have sought to modify Yalcinalp with such a step? The style sheets in Yalcinalp are used to generate a transformed document for the user in response to a document request (column 5, lines 27-28) and there is no indication in Yalcinalp, or any other evidence presented by the examiner, that there is any problem with the transformation described by Yalcinalp. Moreover, to whatever extent there is an "intermediate stage," as claimed, described by Boag (and we do not agree that there is), the

artisan must have some reason, provided by either of the references, or by something the artisan would be expected to know, to employ such a step in the transformation process of Yalcinalp. We find no such reason.

The examiner seems to think that the applicability of the style sheets would be increased when a style sheet tailored to a particular environment is not readily available. However, the whole point of Yalcinalp's invention is to not require the style sheet to be application dependent (see column 6, lines 2-13). Therefore, Yalcinalp already has "increased the applicability of style sheets" without any modification from Boag.

Since we are not convinced that the applied references describe each step of the instant claims or that the artisan would have been led to combine the references even if all steps were disclosed, we will not sustain the rejection of claims 1-23 under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

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HARRINGTON & SMITH, L.L.P.
4 RESEARCH DRIVE
SHELTON, CT 06484-6212